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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,765	01/29/2002	Nobuyuki Itoh	201130.408D1	9697

22504 7590 03/15/2006

DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

EXAMINER

LI, RUIXIANG

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,765

Applicant(s)

ITOH ET AL.

Examiner

Ruixiang Li

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Sequence alignment</u> . |

DETAILED ACTION

Status of Application, Amendments, and/or Claims

The amendment filed on 01/11/2006 has been entered in full. Claim 15 has been amended. Claims 15-18 are pending and under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

During a telephone interview with Jane E. R. Potter on February 3, 2006, the Examiner proposed an Examiner's amendment to allow the allowable subject matter. The Examiner called Applicants' representative several times to discuss the issue. However, no answer was given. Accordingly, a non-final rejection is set forth below.

Withdrawn Objections and/or Rejections

The rejection of claims 15-18 under 35 U.S.C. 112, first paragraph for scope of enablement has been withdrawn in view of amended claim 15.

The rejection of claims 15 and 16 under 35 U.S.C. 112, first paragraph for written description has been withdrawn in view of amended claim 15.

Claim Rejections under Double Patenting

The provisional rejection of claim 15-18 under 35 U.S.C. 101 as claiming the same invention as that of claims 15-18 of copending Application No. 10/771, 173 is maintained.

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Claim Rejections under 35 USC §102 (e)

Claims 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards et al. (U. S. Patent No. 6639063, October 28, 2003; 102(e) date: August 5, 1999).

Edwards et al. teach a polypeptide comprising amino acids 1 to 79 of the polypeptide of SEQ ID NO: 4 of the present invention (see attached sequence alignment). The polypeptide taught by Edwards et al. comprises the amino acid sequence of SEQ ID NO: 7. Edwards et al. also teach an epitope-containing fragment comprising a contiguous span of at least 10 amino acids of the polypeptide (lines 40-47 of column 20), meeting the limitations of claims 15-17.

Claim Objection

Claim 18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claims are allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00

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pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Brenda.Brumback@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



RUIXIANG LI, PH.D.
PRIMARY EXAMINER

Ruixiang Li, Ph.D.
Primary Examiner
March 10, 2006

977 5 2.4 6 1 US-08-841-483-28 Sequence 28, Appl
978 5 2.4 6 2 US-09-382-911-28 Sequence 21, Appl
979 5 2.4 6 2 US-09-232-446B-21 Sequence 21, Appl
980 5 2.4 6 2 US-09-551-737C-68 Sequence 68, Appl
981 5 2.4 6 2 US-09-640-138D-30 Sequence 30, Appl
982 5 2.4 6 2 US-09-077-948A-134 Sequence 134, Appl
983 5 2.4 6 2 US-09-077-948A-135 Sequence 135, Appl
984 5 2.4 6 2 US-09-639-667-28 Sequence 28, Appl
985 5 2.4 6 2 US-09-551-738B-57 Sequence 57, Appl
986 5 2.4 6 2 US-08-944-133-15 Sequence 15, Appl
987 5 2.4 7 2 US-09-258-754-403 Sequence 403, Appl
988 5 2.4 7 2 US-09-258-754-422 Sequence 422, Appl
989 5 2.4 7 2 US-09-042-107-403 Sequence 403, Appl
990 5 2.4 7 2 US-09-042-107-422 Sequence 422, Appl
991 5 2.4 7 2 US-09-722-250D-403 Sequence 403, Appl
992 5 2.4 7 2 US-09-722-250D-422 Sequence 422, Appl
993 5 2.4 7 2 US-09-676-475A-403 Sequence 403, Appl
994 5 2.4 7 2 US-09-676-475A-422 Sequence 422, Appl
995 5 2.4 7 2 US-10-607-595-403 Sequence 403, Appl
996 5 2.4 7 2 US-10-607-595-422 Sequence 422, Appl
997 5 2.4 7 4 PCT-US94-01840-8 Sequence 8, Appl
998 5 2.4 7 6 5194592-40 Patent No. 5194592
999 5 2.4 8 1 US-08-841-483-29 Sequence 29, Appl
1000 5 2.4 8 2 US-09-045-632-102 Sequence 102, Appl

ALIGNMENTS

RESULT 1
US-09-715-805-4
; Sequence 4, Application US/09715805
; Patent No. 6716626
; GENERAL INFORMATION:
; APPLICANT: Itoh, No. 6713626yuyuki
; APPLICANT: Kavanaugh, W. Michael
; TITLE OF INVENTION: HUMAN FGF-21 GENE AND GENE EXPRESSION
; FILE REFERENCE: PRODUCTS
; FILE REFERENCE: PP-16758.001/201130.408
; CURRENT APPLICATION NUMBER: US/09/715,805
; CURRENT FILING DATE: 2000-11-16
; NUMBER OF SEQ ID NOS: 17
; SOFTWARE: FastSeq for Windows Version 4.0
; SEQ ID NO 4
; LENGTH: 209
; TYPE: PRT
; ORGANISM: Homo sapiens
US-09-715-805-4

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Best Local Similarity 100.0%; Pred. No. 8.4e-193;
Matches 209; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
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Db 121 CSFRELLEDGYNVYQSEAHGLPLHLPGNKSHPHDPAPRGPARFLPLPGLPPGI 180
Qy 181 LAPQPPDVGSSDPLSMVGPQGRSPSYAS 209
Db 181 LAPQPPDVGSSDPLSMVGPQGRSPSYAS 209

RESULT 2
US-09-390-207-2
; Sequence 2, Application US/09390207

; Patent No. 6504530
; GENERAL INFORMATION:
; APPLICANT: Thomason, Arlen
; APPLICANT: Liu, Benxian
; TITLE OF INVENTION: Fibroblast Growth Factor-Like Polypeptides
; FILE REFERENCE: 99-371
; CURRENT APPLICATION NUMBER: US/09/390,207
; CURRENT FILING DATE: 1999-09-07
; NUMBER OF SEQ ID NOS: 41
; SOFTWARE: Patentin Ver. 2.0
; SEQ ID NO 2
; LENGTH: 209
; TYPE: PRT
; ORGANISM: Homo sapiens
US-09-390-207-2

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Matches 173; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
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RESULT 3
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; Sequence 5, Application US/09390207
; Patent No. 6504530
; GENERAL INFORMATION:
; APPLICANT: Thomason, Arlen
; APPLICANT: Liu, Benxian
; TITLE OF INVENTION: Fibroblast Growth Factor-Like Polypeptides
; FILE REFERENCE: 99-371
; CURRENT APPLICATION NUMBER: US/09/390,207
; CURRENT FILING DATE: 1999-09-07
; NUMBER OF SEQ ID NOS: 41
; SOFTWARE: Patentin Ver. 2.0
; SEQ ID NO 5
; LENGTH: 181
; TYPE: PRT
; ORGANISM: Homo sapiens
US-09-390-207-5

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Db 61 GVITQILGVKTSRFLCQPDGALYGSILHFDPEACSFRELLEDGYNVYQSEAHGLPLH 120
Qy 149 NKSPHDPAPRGPARFLPLPGLPPA 173
Db 121 NKSPHDPAPRGPARFLPLPGLPPA 145

RESULT 4
US-09-621-976-5213
; Sequence 5213, Application US/09621976
; Patent No. 6639063

60/147, 499 filed on Aug. 5, 1999.

GENERAL INFORMATION:
; APPLICANT: Dumas Milne Edwards, J.B.
; APPLICANT: Jobert, S.
; APPLICANT: Giordano, J.Y.
; TITLE OF INVENTION: ESTs and Encoded Human Proteins.
; FILE REFERENCE: GENSET.054PR2
; CURRENT APPLICATION NUMBER: US/09/621,976
; CURRENT FILING DATE: 2000-07-21
; NUMBER OF SEQ ID NOS: 19335
; SOFTWARE: Patent.pm
; SEQ ID NO 5213
; LENGTH: 85
; TYPE: PRT
; ORGANISM: Homo sapiens
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; LOCATION: 57
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US-09-621-976-5213

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Qy 61 LEIREDTGVGAADQSPES 79
Db 61 LEIREDTGVGAADQSPES 79

RESULT 5
US-09-390-207-6
; Sequence 6, Application US/09390207
; Patent No. 6504530
; GENERAL INFORMATION:
; APPLICANT: Thomason, Arlen
; APPLICANT: Liu, Benxian
; TITLE OF INVENTION: Fibroblast Growth Factor-Like Polypeptides
; FILE REFERENCE: 99-371
; CURRENT APPLICATION NUMBER: US/09/390,207
; CURRENT FILING DATE: 1999-09-07
; NUMBER OF SEQ ID NOS: 41
; SOFTWARE: Patentin Ver. 2.0
; SEQ ID NO 6
; LENGTH: 181
; TYPE: PRT
; ORGANISM: Mus musculus
US-09-390-207-6

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Best Local Similarity 100.0%; Pred. No. 7.6e-21;
Matches 30; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
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Db 87 HFDPEACSFRELLLEDGYNVQSEAHGLPL 116

RESULT 6
US-09-390-207-4
; Sequence 4, Application US/09390207
; Patent No. 6504530
; GENERAL INFORMATION:
; APPLICANT: Thomason, Arlen
; APPLICANT: Liu, Benxian

; TITLE OF INVENTION: Fibroblast Growth Factor-Like Polypeptides
; FILE REFERENCE: 99-371
; CURRENT APPLICATION NUMBER: US/09/390,207
; CURRENT FILING DATE: 1999-09-07
; NUMBER OF SEQ ID NOS: 41
; SOFTWARE: Patentin Ver. 2.0
; SEQ ID NO 4
; LENGTH: 210
; TYPE: PRT
; ORGANISM: Mus musculus
US-09-390-207-4

Query Match 14.4%; Score 30; DB 2; Length 210;
Best Local Similarity 100.0%; Pred. No. 8.7e-21;
Matches 30; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
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Db 116 HFDPEACSFRELLLEDGYNVQSEAHGLPL 145

RESULT 7
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; Sequence 2, Application US/09715805
; Patent No. 6716626
; GENERAL INFORMATION:
; APPLICANT: Itch, No. 6716626uyuki
; APPLICANT: Kavanaugh, W. Michael
; TITLE OF INVENTION: HUMAN FGF-21 GENE AND GENE EXPRESSION
; TITLE OF INVENTION: PRODUCTS
; FILE REFERENCE: PR-16758.001/201130.408
; CURRENT APPLICATION NUMBER: US/09/715,805
; CURRENT FILING DATE: 2000-11-16
; NUMBER OF SEQ ID NOS: 17
; SOFTWARE: FastSEQ for Windows Version 4.0
; SEQ ID NO 2
; LENGTH: 210
; TYPE: PRT
; ORGANISM: Mus musculus
US-09-715-805-2

Query Match 14.4%; Score 30; DB 2; Length 210;
Best Local Similarity 100.0%; Pred. No. 8.7e-21;
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Db 116 HFDPEACSFRELLLEDGYNVQSEAHGLPL 145

RESULT 8
US-09-665-493B-7
; Sequence 7, Application US/09665493B
; Patent No. 6543153
; GENERAL INFORMATION:
; APPLICANT: Manning, William C., Jr.
; APPLICANT: Dwaraki, Varavani J.
; APPLICANT: Rendahl, Katherine
; APPLICANT: Zhou, Shang-Zhen
; APPLICANT: McGee, Laura H.
; APPLICANT: Lau, Dana
; APPLICANT: Flannery, John G.
; APPLICANT: Miller, Sheldon
; APPLICANT: Wang, Fei
; APPLICANT: Di Polo, Adriana
; TITLE OF INVENTION: USE OF RECOMBINANT GENE DELIVERY VECTORS
; TITLE OF INVENTION: FOR TREATING OR PREVENTING DISEASES OF THE EYE
; FILE REFERENCE: PP1588.005 (20263.40)
; CURRENT APPLICATION NUMBER: US/09/665,493B
; CURRENT FILING DATE: 2000-09-20
; NUMBER OF SEQ ID NOS: 12
; SOFTWARE: FastSEQ for Windows Version 4.0
; SEQ ID NO 7

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Provisional application of Patent No. 6639063.